



#16
6/13/03

PATENT
P54428RE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: SEUNG-CHEOL HONG *et al.*

Original Patent No. 5,944,830 issued on 31 August 1999

Serial No.: 09/942,961

Examiner: DHARIA, RUPAL

Filed: 31 August 2001

Art Unit: 2181

For: REDUCING POWER CONSUMPTION IN MONITOR BY SWITCHING OFF
HEATER POWER IN POWER-OFF MODE

PETITION FOR REVIEW OF THE DIRECTOR'S DECISION

UNDER 37 C.F.R. §1.181(a)(3)

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JUN 04 2003

Technology Center 2100

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant respectfully petition from the Examiner's imposition of the finality in the Office
action (Paper No. 12) mailed on 2 April 2003, and as reasons therefore, states that:

Folio: P54428RE

Date: 5/30/03

I.D.: REB/DC/kf

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OFFICE OF PETITIONS

STATEMENT OF FACTS

1. On page 2 of Paper No. 10 (mailed 19 November 2002), the Examiner improperly rejects claims 11-33, 35, 36, 38, 42, 43, 46, 55, 56, and 60 under § 103(a) as being unpatentable over particular portions of the Applicants' disclosure in view of Heineman (U.S. Patent 5,465,366). More specifically, the Examiner improperly rejects claims 11-33, 35, 36, 38, 42, 43, 46, 55, 56, and 60 under § 103(a) as being unpatentable over alleged "Applicant's Admitted Prior Art" (AAPA) in view of Heineman.
2. In the Response filed by the Applicants 19 February 2003, the Applicants explain why the term "earlier" is not equivalent to the phrase "prior art", and explain that the phrase "prior art" has a special meaning as set forth specifically by 35 U.S.C. §§ 102, 103.
3. On page 2 of Paper No. 12 (mailed 2 April 2003), the Examiner improperly rejects claims 11-33, 35, 36, 38, 42, 43, 46, 55, 56, and 60 under § 103(a) as being unpatentable over particular portions of the Applicants' disclosure in view of Heineman (U.S. Patent 5,465,366). More specifically, the Examiner improperly rejects claims 11-33, 35, 36, 38, 42, 43, 46, 55, 56, and 60 under § 103(a) as being unpatentable over alleged "Applicant's Admitted Prior Art" (AAPA) in view of Heineman. The Examiner appears to have dismissed, without serious consideration, the Applicants' remarks regarding the fact that "earlier" is not equivalent to "prior art".
4. On 12 May 2003 the Applicants' attorney telephoned the Examiner to request that the finality of Paper No. 12 be withdrawn, but did not receive an assurance by the Examiner that the finality of Paper No. 12 would be withdrawn or reconsidered.

5. Applicants filed a Petition on 12 May 2003 requesting reconsideration of the finality of the last Office action.
6. In a Decision mailed 28 May 2003, the U.S. Patent & Trademark Office denied the Applicant's request for reconsideration.

REMARKS

The Applicants respectfully believe that Paper No. 12 is a premature final Office action because the Applicants have not yet received the full cooperation from the Examiner regarding the issue of "prior art". It is respectfully believed that the Paper No. 12 should have been a non-final Office action.

The term "prior art" is defined by the U.S. Patent Statutes, namely 35 U.S.C. § 103 which defines the term "prior art" by reference to 35 U.S.C. § 102. The long and short of the issue is that the Examiner has no authorization to invent "prior art", given that the United States Congress has already defined the term "prior art" and those items which may be classified as "prior art", by enacting 35 U.S.C. §§102 and 103. Only those items that fall within one or more of the definitions set forth in the several paragraphs of 35 U.S.C. §102 qualify as "prior art." The Examiner's assertion that column 2, paragraphs 4 through 15 of Applicant's background discussion constitutes "prior art" is unwarranted and unlawful under 35 U.S.C. §102. The Group Director's cavalier refusal to address the unauthorized invention of "prior art" by the Examiner, raises serious concerns about the quality of the examination. Reconsideration of the Director's Decision is therefore requested.

The Examiner has not yet cited any evidence showing that Hong's Figure 1, col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60 are "prior art" as the term "prior art" is defined by the U.S. Patent Statutes, namely 35 U.S.C. § 103 which defines the term "prior art" by reference to 35 U.S.C. § 102. The term "prior art" is not used in those sections. The Examiner has not cited any evidence on this issue, and thus the Applicants have not had an opportunity to rebut the evidence. Therefore, the Examiner has not given the Applicants full cooperation on this issue. In view of these facts, the finality of Paper No. 12 is respectfully believed to be *premature*.

The Applicants respectfully submit that the final Office action (Paper No. 12) is a premature final Office action because the Examiner has prematurely, and incorrectly, assumed that the Applicants' Figure 1 is "prior art" *without providing even a scintilla of evidence supporting the*

Examiner's assumption. The Examiner has made this premature and incorrect assumption without establishing a *prima facie* case that such an assumption may be valid. Furthermore, the Examiner has made this premature and incorrect assumption without providing a preponderance of evidence, or any evidence, showing that this assumption may be valid.

Also, the Applicants respectfully submit that the final Office action (Paper No. 12) is a premature final Office action because the Examiner has prematurely, and incorrectly, assumed that the Applicants' col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60 of the Applicants' disclosure are "prior art". The Examiner has made this premature and incorrect assumption without establishing a *prima facie* case that such an assumption may be valid. Furthermore, the Examiner has made this premature and incorrect assumption without providing a preponderance of evidence, or any evidence, showing that this assumption may be valid.

The phrase "prior art" has a special meaning in a patent application. It is not fair, proper, or reasonable for the Examiner to assume that the word "earlier" is equivalent to the phrase "prior art" in this patent application.

On page 2 of Paper No. 12, the Examiner improperly rejects claims 11-33, 35, 36, 38, 42, 43, 46, 55, 56, and 60 under § 103(a) as being unpatentable over particular portions of the Applicants' disclosure in view of Heineman. More specifically, the Examiner improperly rejects claims 11-33, 35, 36, 38, 42, 43, 46, 55, 56, and 60 under § 103(a) as being unpatentable over alleged "Applicant's Admitted Prior Art" (AAPA) in view of Heineman.

The Applicants respectfully traverse this rejection for several reasons, including the fact that the portions of the Applicants' disclosure, as relied upon by the Examiner, are not available to cite as "prior art" in a rejection of claims of the present invention. The Applicants respectfully submit that the Examiner has improperly alleged that particular portions of the Applicants' disclosure, including Figure 1, are deemed to be "Applicant's Admitted Prior Art" (AAPA).

“[C]ertain art may be prior art to one inventive entity, but not to the public in general.” *In re Fout*, 675 F.2d 297, 300-301, 213 USPQ 532, 535-536 (CCPA 1982); M.P.E.P. § 2129. “This is the case when applicant has made an improvement on his or her own prior invention. An applicant's own foundational work should not, unless there is a statutory bar, be treated as prior art solely because knowledge of this work is admitted.” M.P.E.P. § 2129.

Accordingly, the Applicants (hereinafter “Hong”) respectfully request that the Examiner withdraw the § 103 rejection of claims. In Paper No. 12, the Examiner improperly alleges that the following portions of Hong's disclosure are “Applicant's Admitted Prior Art”: Hong's Figure 1, col. 1 at lines 37-67, col. 4 at lines 10-60, col. 1 at lines 23-35, col. 4 at lines 30-43, col. 2 at lines 4-14, col. 4 at lines 47-60, and col. 4 at lines 10-45.

More briefly, the Examiner improperly alleges that the following portions of Hong's disclosure are “Applicant's Admitted Prior Art”: Figure 1, col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60. Hong respectfully submits that Hong's Figure 1, col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60 are not “prior art” and, furthermore, submits that those portions are not admitted by Hong to be “prior art.”

Hong respectfully submits that Hong's Figure 1, col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60 cannot be described as “Applicant's Admitted Prior Art.” Hong's Figure 1, col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60 cannot be cited as “prior art” in a rejection of claims of the present Application, and thus the Examiner is respectfully believed to have improperly rejected claims under § 103.

The Applicants respectfully submit that the word “earlier” is not the equivalent of the term “prior art”. The term “prior art” is defined by reference to 35 U.S.C. §§ 102, 103. A device can be considered to be an “earlier” device by an inventor, even when that device is not “prior art” according to 35 U.S.C. §§ 102, 103. Thus, a first device may have been developed by an inventor on a first date, and then one month later the inventor may develop a second device. In this hypothetical example, the first and second devices are related but not identical. In this example,

the first device is not "prior art" as defined by 35 U.S.C. §§ 102, 103, even if the inventor describes it as "earlier" in a patent application claiming the second device, since the first device was never known or used by others in this country, or patented or described in a printed publication in this country or a foreign country, before the invention thereof by the inventor. In this example, the first device was not patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date afforded the application for the second device. Also, the first device was not made in this country by someone other than the inventor. This example shows that it is possible for a device to be "earlier" (in the opinion of the inventor) but not "prior art" according to 35 U.S.C. §§ 102, 103.

The Examiner has not yet cited any evidence showing that Hong's Figure 1, col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60 are "prior art" as the term "prior art" is defined by the U.S. Patent Statutes, namely 35 U.S.C. § 103 which defines the term "prior art" by reference to 35 U.S.C. § 102.

The Examiner has improperly alleged the word "earlier" is the equivalent of the phrase "prior art" in a patent application. The Examiner has failed to establish a *prima facie* case showing that the word "earlier" should be interpreted as being equivalent to the phrase "prior art". The Examiner failed to show by a preponderance of evidence any reason why the word "earlier" should be interpreted as being equivalent to the phrase "prior art".

In Paper No. 12, on page 4, the Examiner offers a definition of the word "earlier" that includes "near the beginning of a given series". However, the definition provided by the Examiner is not dispositive in determining whether the word "earlier" is equivalent to the phrase "prior art". In fact, the definition provided by the Examiner is not helpful in this issue, because the key point is the text and interpretation of 35 U.S.C. §§ 102, 103. Subject matter will only be considered to be "prior art" when the phrase "prior art" is used by an applicant, or when the conditions set forth in 35 U.S.C. §§ 102, 103 are satisfied (related to a printed publication, a public use, or a sale, etc., more than one year prior to the date afforded the application). In this regard, the Examiner has not demonstrated that **any** of the conditions of 35 U.S.C. §§ 102, 103 are satisfied regarding the

subject matter described as “earlier”. The Examiner merely states that “earlier” subject matter has shortcomings, and merely offers a dictionary definition of “earlier” which does not explicitly relate to printed publications, public use, or a sale more than one year prior to an application date.

Neither the U.S. Patent Statutes (35 U.S.C. §§ 1-376), the Rules of Practice in Patent Cases (37 C.F.R. §§ 1.1-1.825), nor any other authority supports the Examiner's allegation.

Hong's Figure 1, col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60 are not believed to be “prior art” as that term is defined by the U.S. Patent Statutes, namely 35 U.S.C. § 103 which defines the term “prior art” by reference to 35 U.S.C. § 102. Hong's Figure 1, col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60 represent an abstract representation prepared specifically by Hong in an effort to illustrate Hong's discovery of the problems that have long plagued this area. This discovery is itself, together with Hong's abstract representation as disclosed in Hong's Figure 1, col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60, an integral part of Hong's disclosed invention. By identifying deficiencies of the art and then addressing those deficiencies, Hong completes the inventive process. As such, Hong's effort to identify deficiencies or other undesirable features in the art does not constitute “prior art” as that term is defined by the U.S. Patent Statutes, namely 35 U.S.C. § 103 which defines the term “prior art” by reference to 35 U.S.C. § 102. Therefore, Hong's Figure 1, col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60 are Hong's work product and are the Hong's effort to describe the invention in terms of the problems which have plagued this area. Hong has addressed the problems which have plagued this area with the inventions defined by the pending claims.

When the Examiner improperly describes Hong's Figure 1 as “Applicant's Admitted Prior Art,” this suggests that this figure itself constitutes “prior art.” This is clearly not correct.

When the Examiner improperly describes Hong's col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60 as “Applicant's Admitted Prior Art,” this suggests that these

portions of Hong's disclosure constitute "prior art." This is clearly not correct.

Hong respectfully notes that the claims define Hong's invention, and the specification provides a description of the claimed invention. Moreover, the subject matter of Hong's Figure 1, col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60 is expressly discussed in the specification, and nothing in the claims or the specification would suggest that Hong's Figure 1, col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60 depict the claimed invention.

Furthermore, not every item shown in the drawings is necessarily defined by a pending claim. In addition, the earlier work of Hong is represented by some of the drawings, and is not necessarily claimed.

The term "related art" was used in the original disclosure. Hong used this term in order to help explain information that is known to Hong to help highlight improvements made by Hong. Hong respectfully submits that this use of this term is well within the range of consistency with the ordinary meaning for this term, whatever one considers to be the ordinary meaning. Therefore, Hong is entitled to use this term for the meaning Hong has given it. Furthermore, Hong respectfully submits that this term is not the equivalent of "prior art," as "prior art" is defined by the U.S. Patent Statutes, namely 35 U.S.C. § 103 which defines the term "prior art" by reference to 35 U.S.C. § 102.

"[C]ertain art may be prior art to one inventive entity, but not to the public in general." *In re Fout*, 675 F.2d 297, 300-301, 213 USPQ 532, 535-536 (CCPA 1982); M.P.E.P. § 2129. "This is the case when applicant has made an improvement on his or her own prior invention. An applicant's own foundational work should not, unless there is a statutory bar, be treated as prior art solely because knowledge of this work is admitted." M.P.E.P. § 2129.

The present Application is based on a translation of Korean application 1996-4299 and a Korean application 1996-6135, on which Hong has claimed priority as evidenced by the

Declaration (Oath). Accordingly, the terms therein can, at most, only be considered with reference to Korea, not this country. M.P.E.P. § 706.02(c) states, in part: "The language 'in this country' means in the United States only and does not include other WTO or NAFTA member countries."

Importantly, as evidenced from the Declaration/Oath, the Applicants are citizens of Korea, and, as such, performed work in Korea in order to obtain the results disclosed in Figure 1, col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60. There has been no showing, and the Applicants have never admitted, that the Applicants' Figure 1, col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60 were ever known or used by others in this country, or patented or described in a printed publication in this country or a foreign country, before the invention thereof by the Applicants. Further, there has been no showing that the features, as depicted in Figure 1, col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60, were patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date afforded the present invention. Also, there has been no showing that the features, as depicted in Figure 1, col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60, were ever made in this country by someone other than the Applicants.

Hong respectfully submits that under these facts the law does not allow the Examiner to improperly allege, in a premature final Office action, that Hong's Figure 1, col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60 can be described as "Applicant's Admitted Prior Art," at least when Hong has heretofore only attempted in good faith to comply with the Rules of Practice in Patent Cases (37 C.F.R. §§ 1.1-1.825).

Hong respectfully requests that the Examiner withdraw the finality of Paper No. 12 and adhere to the guidelines dictating that "related art" is not equivalent to "admitted prior art." Hong respectfully requests that the Examiner withdraw the label of "Applicant's Admitted Prior Art" from the related art set forth in the present Application.

In view of the foregoing, Hong respectfully believes that the Hong's Figure 1, col. 1 at lines

23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60 cannot be labeled as "Applicant's Admitted Prior Art."

Accordingly, Hong respectfully requests that the Examiner withdraw the finality of the § 103 rejection of claims 11-33, 35, 36, 38, 42, 43, 46, 55, 56, and 60. Also, because all pending independent claims are believed to be allowable, Hong respectfully requests that the Examiner withdraw the finality of the objection to claims 34, 37, 39-41, 44, 45, 47, 48, and 57-59.

The Applicants respectfully submit that the final Office action (Paper No. 12) is a premature final Office action, because the Examiner has prematurely, and incorrectly, assumed that the Applicants' Figure 1 is "prior art", and because the Examiner has prematurely, and incorrectly, assumed that col. 1 at lines 23-35 and 37-67, col. 2 at lines 4-14, and col. 4 at lines 10-60 of the Applicants' disclosure are "prior art". The Examiner has made these premature and incorrect assumptions without establishing a *prima facie* case that such assumptions are valid. Furthermore, the Examiner has made these premature and incorrect assumptions without providing a preponderance of evidence showing that these assumptions are valid. The phrase "prior art" has a special meaning in a patent application. It is not fair or reasonable for the Examiner to assume that the word "earlier" is equivalent to the phrase "prior art" in a patent application.

RELIEF REQUESTED

In view of the above, Applicant respectfully requests the Commissioner to:

- A. Reconsideration of the finality of Paper No. 12;
- B. Withdrawal of the finality of the last Office action;
- C. Issuance of a new Office action that is not a final Office action; and
- D. Other relief as justice may require.

Applicant believes that no fee is incurred by this Petition. However, should any fee be incurred, the Commissioner is authorized to charge such fee to Deposit Account No. 02-4943 of Applicant's undersigned attorney.

Respectfully submitted,



Robert E. Bushnell,
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

Folio: P54428RE
Date: 5/30/03
I.D.: REB/DC